

selecting an area of skin on a human from which reduced androgen-stimulated hair growth is desired; and

H3  
cont  
applying to said area of skin a dermatologically acceptable composition comprising an inhibitor of mast cell degranulation in an amount effective to reduce androgen-stimulated hair growth.--

Amend claim 75 to read as follows:

38 45 50 53 63 65 68 71  
39, 46, 51, 54, 64, 66, 69, 72, or 74, wherein said area of skin  
H3  
is on a human. [00]--

In claim 76, line 1, replace "27" with --1--.

In claim 77, line 1, delete "27,".

Add new claim 78:

H4  
73  
--78. (New) The method of claim 1 or 42, wherein said  
area of skin comprises the beard area.--

#### REMARKS

Applicants have further amended claims 1 and 42 to specify that the hair growth targeted for reduction is androgen-stimulated hair growth. These claims already require application of the composition to the skin of a human. In view of the scope of claim 1 as amended, claim 27 has been cancelled and multiple dependent claims 75 and 77 have been amended to remove the dependency from claim 27. New claim 78 depends from claims 1 and 42 and requires application of the composition to the beard area.

Applicants have amended claims 1 and 42 to specify that the hair growth is androgen-stimulated hair growth in the interests of advancing prosecution. In the office action dated

October 6, 1998, the Examiner indicated that a claim limited to applying mycophenolic acid to skin in the beard area of a human would be allowable. Applicants have not amended claims 1 and 42 to require that the composition include mycophenolic acid, or to require application to the beard area. But applicants submit that the claims as amended are in condition for allowance based on the same rationale that the claims amended as suggested by the Examiner would be in condition for allowance, for the following reasons.

The lack of enablement rejection based on JP '923 involves only mycophenolic acid. Thus, if the Examiner believes that a claim directed to applying mycophenolic acid to the beard area of a human satisfies the enablement requirements of 35 U.S.C. § 112, ¶ 1, it follows that generic claims covering applying a non-steroidal suppressor of angiogenesis (claim 1) or an inhibitor of mast cell degranulation (claim 42) also satisfy the enablement requirements of 35 U.S.C. § 112, ¶ 1 in view of JP '923. As a result, there is no reason for applicants to limit the claims to require application of mycophenolic acid.

Moreover, the Examiner apparently has recognized that the Golden Syrian hamster flank organ is an accepted model for the human beard. But human beard growth is androgen-stimulated, and the Golden Syrian hamster flank organ model is an accepted model for androgen-stimulated hair growth generally. (See paragraph 2 of the Declaration of Dr. Ahluwalia submitted March 26, 1998.) As a result, claims limited to applying the composition to areas of skin from which reduced androgen-

stimulated hair growth is desired satisfy the enablement requirements of 35 U.S.C. § 112, ¶ 1, and there is no reason for applicants to limit the claims to require application to the beard area.

Applicants believe that claims 1 and 42 prior to this amendment satisfied the requirements of 35 U.S.C. § 112, ¶ 1 in view of JP '923 for the reasons explained in the preliminary remarks submitted on March 26, 1998. Accordingly, although applicants have amended claim 1 to advance prosecution, they reserve the right to pursue the broader claim in a future continuation or divisional application.

The Examiner believes claims 75 and 77 are duplicates. Applicants disagree. Not all hair growing from the skin of a human is androgen-stimulated. Scalp hair, for instance, is not androgen-stimulated. (See paragraph 3 of the Declaration of Dr. Ahluwalia submitted March 26, 1998.) Since claim 77 requires application of the composition to hair growth that is androgen-stimulated, whereas claim 75 does not. As a result, they are not duplicative.

Applicants also note that the Examiner did not apply the lack of enablement rejection under 35 U.S.C. § 112, ¶ 1 based on JP '923 to claim 77, whereas claim 75 was rejected on these grounds. Thus, the Examiner implicitly recognized that the claims are of different scope.

Claims 6 and 8 also literally cover use of mycophenolic acid. See page 4, lines 26-29 of the application. Thus, these

claims also should be examined based on applicants election of mycophenolic acid.

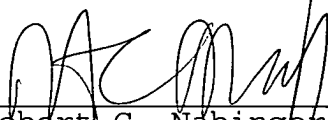
Applicants have not amended independent claims 30, 33, 36, 39, 42, 46, 51, 54, 64, 69, 72, and 74 to require application to the skin of a human or to an area of skin from which reduced androgen-stimulated hair growth is desired because these claims do not cover using mycophenolic acid. Thus, the JP '923 issues does not come up with these claims.

Applicants submit that the claims are in condition for allowance and such action is requested.

Please charge any additional fees, or make any credits, to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 1/6/99

  
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